

Attorney Ref. No. 26094.002

TRADEMARK LAW OFFICE 104
Serial No. 77/187,693
Mark: LIPFUSION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of :

Fusion Brands International SRL :

Serial No. 77/187,693 :

NOTICE OF APPEAL

Filed: May 22, 2007 :

For Mark: LIPFUSION :

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Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the examining attorney dated March 28, 2008 refusing registration.

This notice of appeal is accompanied by a copy of a response to the final Office action dated March 28, 2008. Applicant respectfully requests that this appeal be suspended and that the case be remanded to the Examining Attorney for consideration of Applicant's Response.

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09-29-2008

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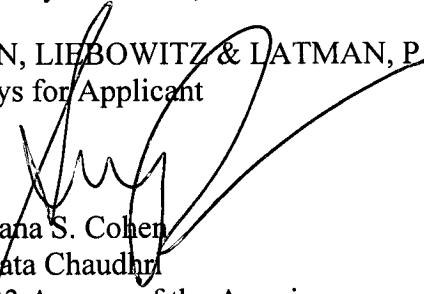
Applicant encloses herewith a check for \$100 in payment of the prescribed appeal fee.

Dated: New York, New York
September 29, 2008

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Applicant

By:


Arlana S. Cohen
Sujata Chaudhri
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

Cc: Jessica A. Powers, Esq., Law Office 104

Attorney Ref. No. 26094.002

TRADEMARK LAW OFFICE 104

Serial No. 77/187,693

Mark: LIPFUSION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of

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Fusion Brands International SRL

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**RESPONSE TO FINAL OFFICE
ACTION DATED MARCH 28, 2008**

Filed: May 22, 2007

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For Mark: LIPFUSION

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Commissioner for Trademarks

P. O. Box 1451

Alexandria, Virginia 22313-1451

Attention: Jessica A. Powers, Esq., Trademark Attorney

Law Office 116

Fusion Brands International SRL ("Applicant") hereby responds to the FINAL Office action dated March 28, 2008 in connection with the above-identified service mark application.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on

09/29/08

(Date of Deposit)

KORNELIA BUTOT

(Print name)

(Signature)

AMENDMENTS

Please amend the identification of services covered by Applicant's application by deleting it in its entirety and substituting the following in lieu thereof:

-- ONLINE RETAIL STORE SERVICES FEATURING APPLICANT'S
COSMETIC BEAUTY PRODUCTS, NAMELY, NON-MEDICATED LIP
PLUMPING GLOSS, LIP PENCILS, AND LIP SHINES --

REMARKS

The Examining Attorney has issued a final refusal to register Applicant's mark, LIPFUSION on the ground of likelihood of confusion with Registration No. 2,998,981, LIP INFUSION, covering "medicated topical creams, lotions, gels, and/or ointments for human use and for lip and skin dryness, cold sores, burns, itching, for lip and skin care, topical analgesic preparations, topical antibiotic creams, lotions, gels, and/or ointments and medicated topical sun screen creams, lotions, gels, and/or ointments for use on the lips and skin" in class 5. Registration No. 2,998,981 is hereinafter referred to as the "Cited Registration." According to the Examining Attorney, there is a likelihood of confusion between Applicant's mark, LIPFUSION, and the Cited Registration. As per the Examining Attorney, substitution of the word "fusion" in lieu of "infusion" in Applicant's mark does not distinguish the mark from the Cited Registration. Furthermore, she states that the parties' goods and services are related because "consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods."

Applicant respectfully states that the Examining Attorney's analysis regarding the parties' marks is flawed. This is simply not a case in which deletion of wording from a registered mark results in a mark that has the same appearance, sound and connotation as the registered mark. The Examining Attorney has admitted that the parties' marks are different phonetically. Although the Examining Attorney states that the phonetic differences are slight, these differences, when combined with the difference in the marks' connotations, render the parties' marks dissimilar and, therefore, unlikely to be confused. Applicant's one word mark LIPFUSION combines the words "lip" and "fusion." As per the Examining Attorney, "fusion" means "a union resulting from a fusing." Thus, when "fusion" is combined with "lip", the natural meaning of the resulting term "LipFusion" is "union of lips resulting from their fusing together." Taken in the context of Applicant's goods, LIPFUSION is a suggestive term that refers to the lip plumping capabilities of Applicant's lip plumping lip products. On the other hand, "infusion" is defined as "the act or process of infusing." Thus, the natural meaning of the phrase "Lip Infusion" is "the act or process of infusing into the lips." Thus, LIP INFUSION as used in connection with Registrant's medicated products, connotes that these products infuse moisture into a consumer's lips so as to repair and soothe them. It follows that the parties' marks have different connotations and are unlikely to be confused.

Moreover, the parties' respective goods and services are unrelated. The Examining Attorney states that Applicant's retail services will feature Registrant's goods. Applicant has amended its application to clarify that Applicant sells its own cosmetic beauty products

through its online retail store. Thus, Applicant's online retail store is not like a general retail store that sells goods manufactured by many different parties. Rather, Applicant's retail store features only Applicant's goods that are targeted towards others. It follows that Applicant's retail online store will not feature Registrant's medicated goods. Thus, there is no likelihood of confusion because consumers will not encounter Applicant's mark and the Cited Registration together. The cases cited by the Examining Attorney are inapposite and should not be given any weight because in all these cases, the retail services were unrestricted. For instance, *In re Hyper Shoppes, Inc.*, 6 U.S.P.Q.2d 1025 (Fed. Cir. 1988), the applicant used the mark BIGG'S for a general merchandise store that sold goods, including furniture, and the registrant used the identical mark BIGG'S for furniture. By contrast, here, Applicant's online retail store does not sell medicated products of the type sold by Registrant. Rather, Applicant sells its own non-medicated cosmetic lip products through the online store. Similarly, *In re U.S. Shoe Corp.*, 229 U.S.P.Q. 707 (T.T.A.B. 1985) is also not applicable because in that case the applicant's description of its store services was not restricted to the sale of any particular type of clothing. Thus, the Board held that sale of uniform skirts and dresses, for example, falls plainly within the applicant's description of its services. Such is not the case here because Applicant's description of its store services is restricted to the sale of Applicant's cosmetic lip products.

The Examining Attorney has attached evidence showing that "the same parties sell goods under the same name as their retail services." This evidence should not be given any weight because it flouts the rule that the Examining Attorney must consider the goods and

services as described in the Cited Registration and Applicant's application. The Cited Registration covers medicated goods, whereas Applicant's application covers non-medicated lip products that are cosmetic in nature. For the purposes of this analysis, it should not matter that parties offer retail store services and goods under the same name. Lastly, the Examining Attorney's contention that "although the registrant's products are medicated, retail beauty stores often sell medicated, retail beauty stores often sell medicated as well as non-medicated products" is irrelevant because Applicant has amended the identification of its retail services to clarify that it sells only its own products.

Due to all the above reasons, there is no likelihood of confusion between the parties' marks.

CONCLUSION

Based on the foregoing amendment and remarks, Applicant believes that it has satisfied all of the Examining Attorney's requirements. Accordingly, Applicant requests that Applicant's application be passed to publication.

Dated: September 29, 2008
New York, New York

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Applicant

By: _____

Arlana S. Cohen
Sujata Chaudhri

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New York, New York 10036-6799
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cc: Trademark Trial and Appeal Board ✓